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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,259	07/29/2003	Jih-Ru Hwu	BHT-3107-123	5436

7590 02/10/2005

TROXELL LAW OFFICE PLLC
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5205 LEESBURG PIKE
FALLS CHURCH, VA 22041

EXAMINER

PAK, JOHN D

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 02/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/628,259	HWU ET AL.	
	Examiner	Art Unit	
	JOHN PAK	1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-14 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

Claims 1-14 are pending in this application.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 2 and 10, drawn to an antibacterial, antiviral and antifungal composition and method for making said composition, wherein component (B) is an ionic compound, classified in multiple subclasses in classes 424 and 514 depending on the structure of the compound, such as for example, class 424, subclasses 601, 606, 663, 665, 669-671, 676-677, 679-680, 703, 709, 713, 722, 723, class 514, 557-560.
- II. Claims 3-4 and 11-12, drawn to an antibacterial, antiviral and antifungal composition and method for making said composition, wherein component (B) is a sulfur compound, classified in multiple subclasses in classes 424 and 514 depending on the structure of the compound, such as for example, class 514, subclasses 553, 556, 706, 708-711.
- III. Claims 5 and 13, drawn to an antibacterial, antiviral and antifungal composition and method for making said composition, wherein component (B) is a coenzyme having reducing ability, classified in class 424, subclasses 94.1+.
- IV. Claims 6 and 14, drawn to an antibacterial, antiviral and antifungal composition and method for making said composition, wherein component (B) is an agent having oxidizing ability, classified in multiple subclasses in

classes 424 and 514 depending on the structure of the compound, such as for example, class 424, subclass 616, class 514, subclass 690.

Claims 1 and 7-9 link inventions I, II, III and IV. The restriction requirement between the linked inventions is subject to the nonallowance of the linking claim(s), claims 1 and 7-9. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

The four inventions as set forth above are distinct because of their use of distinct composition ingredients. The compounds or substances used in component (B) are materially different in each of the invention groups, separately classified, and possess divergent structures. Further, the search for one invention group would already be of sufficient burden given the extremely broad scope of component (A), which is inclusive

of major compounds known for Ni, Co, Mg, Mn, Cr, Ca, Fe, Cu, Ti, Al, Sb, Sn, Pb, Zn, Pt, Pd, Os, Ru, Cd, Rh, Ir, NH₄. With such a breadth of scope, the search burden is quite substantial already for just one invention group. The additional search and examination burden presented by the divergent components in (B) would raise the burden to a level that would be serious and undue.

Therefore, for reasons of distinctness and undue burden, the restriction requirement as set forth above is deemed to be proper.

A telephone call was made to Mr. Troxell and a voicemail message was left on 11/8/2004 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to JOHN PAK whose telephone number is **(571)272-0620**. The Examiner can normally be reached on Monday to Friday from 8 AM to 4:30 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's SPE, Gary Kunz, can be reached on **(571)272-0887**.

The fax phone number for the organization where this application or proceeding is assigned is **(571)273-8300**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571)272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JOHN PAK
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